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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/026,467  | 12/27/2001  | Hidehei Kageyama     | NO. 49              | 7790             |
| 21254   | 7590        | 04/05/2005           | EXAMINER            |                  |
| MCGINN & GIBB, PLLC<br>8321 OLD COURTHOUSE ROAD<br>SUITE 200<br>VIENNA, VA 22182-3817 |             |                      | PRUNNER, KATHLEEN J |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3751                |                  |

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                 |                  |
|------------------------------|---------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.                 | Applicant(s)     |
|                              | 10/026,467                      | KAGEVARNA ET AL. |
|                              | Examiner<br>Kathleen J. Prunner | Art Unit<br>3751 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 December 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-23 and 25-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 1,4,5,11-23 and 25-27 is/are allowed.

6) Claim(s) 6 and 10 is/are rejected.

7) Claim(s) 7, 8 and 9 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The following informalities in the claims are noted: (A) in claim 6, on line 2, a semi-colon should be inserted after "purpose"; (B) in claim 9, on line 6, "holder" should read --holders--; and (C) in claim 20, on line 11, "said" (both second and third occurrences) should be changed to read --each--.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Michael. Michael discloses a composite holding device having all the claimed features including a holder body (constituted by section A) for holding a first medium (constituted by pen X) to serve a prescribed purpose, and a cap (constituted by section B) for detachably covering the holder body A (note Fig. 1), wherein the cap B comprises a casing for accommodating a plurality of holders (constituted by pens X-1 and X-2), each holder holding a second medium to serve a purpose different from and similar to that of the first medium X, a supporting section (constituted by pen blocks 15) for supporting the holders to be movable in an axial direction in the casing (note Figs. 1 and 2), a feed mechanism (constituted by sliding frame members 12), provided in the casing, for selectively advancing one of the plurality of holders (note Figs. 1 and 2), and a manipulating mechanism (constituted by knob 20') for operating the feed mechanism 12 being adapted to project a tip of one of the plurality of holders X-1 and X-2 out of a fore end opening at a tip of

the casing (note Fig. 2) and make usable the tip of one of the plurality of holders X-1 and X-2. With respect to claim 10, Michael also discloses that the media is ink (note lines 4-7 on page 1).

***Allowable Subject Matter***

4. Claims 1, 4, 5, 11-23 and 25-27 are allowed.
5. Claims 7, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if claims 7 and 8 are rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments with respect to claims 6 and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Kathleen J. Prunner, whose telephone number is

Art Unit: 3751

571-272-4894. The examiner can normally be reached on Monday through Friday, 5:30 AM to 2 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu, can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JUSTINE R. YU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

3/17/05



Kathleen J. Prunner

March 11, 2005